UNITED STATES PATENT AND TRADEMARK OFFICE

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Paper No. 8

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ROOSEVELT ROAD, SECTION 2
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Director's Office
Office of Patent Publication

In re Application of :
Hsin-Hung Lee, et al. :
Application No. 10/064,382 :
Filed: July 9, 2002 :
Attorney Docket No. 9048-US-PA :

DECISION ON PETITION

This is a decision on the Petition to Withdraw the Holding of Abandonment, received via facsimile transmission August 5, 2003, for the above-identified application.

The petition is **DISMISSED**.

The application was held abandoned for failure to pay the required issue fee within the statutory period of three months from the mailing date of the Notice of Allowance.

The petitioner states that the Fee Transmittal with the Credit Card Payment Form was mailed to the USPTO via UPS on April 29, 2003. To support this assertion petitioner has submitted copies of a faxed response from the United Parcel Service Limited, Part B – Fee(s) Transmittal, Credit Card payment form, and the return post-card, which acknowledges receipt of the Issue Fee by the Patent and Trademark Office on May 22, 2003.

In order for a petition to be granted, the evidence must be sufficient according to one of the following standards:

- **MPEP 503 (postcard receipt as prima facie evidence)**
- **Certificate of Transmission under 37 CFR 1.8(b)**
- **"Express Mail" Mailing under 37 CFR 1.10**

The aforementioned documents unfortunately do not constitute proof of timely mailing under 37 CFR 1.8(b).

By way of explanation, it should be pointed out that 37 CFR 1.8 sets forth two procedures by which an applicant can certify the date on which he/she is mailing or transmitting a document, so that this certified date can then be regarded as the receipt date by the Patent and Trademark Office, even if the document arrives in the Office after the due date.

The first procedure under 37 CFR 1.8 is the Certificate of Mailing. Paragraph (b) of 37 CFR 1.8 allows a petitioner to prove the timeliness of a lost mailing by providing a photocopy of the previously mailed document, a photocopy of its Certificate of Mailing, and a statement attesting on a personal knowledge basis to the timeliness of the mailing. This is a procedure that the petitioner did not use and could not have used, inasmuch as this procedure can be used only for correspondence mailed via the United States Postal Service. MPEP 512 states "The Certificate of Mailing procedure does not apply to papers mailed in a foreign country."

The second procedure under 37 CFR 1.8 is the Certificate of Transmission, which pertains to submission via facsimile. MPEP 512 states that the "Certificate of Transmission procedure, however, also applies to papers transmitted to the Office from a foreign country provided that the correspondence being transmitted is not prohibited from being transmitted by facsimile and is not otherwise precluded from receiving the benefits under 37 CFR 1.8."

37 CFR 1.8(b) is not applicable to the circumstances because the documents were sent via UPS not via facsimile transmission. MPEP 503 is not applicable, since a self-address postcard was not received by the Patent and Trademark Office after the due date of the Issue Fee. 37 CFR 1.10 is not applicable because the applicant did not deposit the paper or fee as "Express Mail" with the United States Postal Service.

In light of the non-compliance of the above, the holding of abandonment cannot presently be withdrawn.

The petitioner should consider petitioning the Commissioner as follows:

File a petition for Revival of Abandoned Application or Lapsed Patent under CFR § 1.137 (a) or (b). The new rule change appears in 65 FR 57057, September 20, 2000.

- Under 37 CFR 1.137(a), a petition for the revival of an ***unavoidably*** abandoned application must include the following:

  (1) The reply required to the outstanding Office action or notice, unless previously filed.
  (2) The petition fee set forth in § 1.17(l);
  (3) A showing to the satisfaction of the Commissioner that the entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition pursuant to this paragraph was unavoidable: and
  (4) Any terminal disclaimer (and fee as set forth in § 1.20(d) required pursuant to paragraph (d) of this section.

  With respect to an application filed before June 8, 1995, any petition under § 1.137(a) that is filed more than six months after the abandonment date must —according to § 1.137(c)—be accompanied by a terminal disclaimer with disclaimer fee.

- Under 37 CFR 1.137(b), a petition for the revival of an ***unintentionally*** abandoned application must include the following:

  (1) The reply required to the outstanding Office action or notice, unless previously filed.
  (2) The petition fee as set forth in § 1.17(m);
  (3) A statement that the entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition pursuant to this paragraph was unintentional. The Commissioner may require additional information where there is a question whether the delay was unintentional;
  (4) Any terminal disclaimer (and fee as set forth in § 1.20(d) required pursuant to paragraph (d) of this section.

Further correspondence with respect to this matter should be addressed as follows:

By mail:	Commissioner for Patents P.O. Box 1450 Arlington, VA 22313-1450
By facsimile:	703-308-6916 Attn.: Office of Petitions
By hand:	Crystal Plaza Four, Rm. 3C23 2201 South Park Place Arlington, VA

Telephone inquires concerning this matter may be directed to the Office of Petitions at 703-305-5340.

Frederick E. Briscoe

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